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PATENT
Attorney Docket No. 71538

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Fitzgibbon et al.

Appln. No. 09/387,659

Filed: August 31, 1999

Title: GARAGE DOOR OPERATOR SAFETY EQUIPMENT

Group Art Unit: 2837

Examiner: Anthony J. Salata

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

08/13/02
Date

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RESPONSE TO OFFICE ACTION

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

The claims 15-18 of the present application stand finally rejected under 35 U.S.C.§ 101 as representing statutory type double patenting in view of U.S. Patent 5,998,950 (the '950 patent). This is the second rejection of the claims on this basis and the last response by applicant on October 25, 2001 included a thorough discussion concerning double patenting rejections. The response included discussion and the citation of judicial references to support applicant's position that the present claims should not be subject to statutory double patenting rejection. If double patenting exists in the present application it is "obviousness type" double patenting and applicant is willing to submit a Terminal Disclaimer to overcome such an "obviousness type" rejection.

The examiner completely ignores the October 25, 2001 response by applicant and states the following:

> "Claims in different applications need to be more than merely different in form or content and that a patentable distinction must exist to applicant to a second patent.
> See MPEP § 804.03"

The examiner's quote is indeed taken from MPEP § 804.03. Section 804.03 however is not intended to apply here, but applies to situations where there is common ownership of cases with different inventive entities. This is clearly set forth in the title of section 804.03 which is "Treatment of Commonly Owned Cases of Different Inventive Entities". The present application has common ownership and the same inventive entity as '950. The examiner has applied the wrong standard to the present case.

The appropriate standard is set forth in applicant's prior response and throughout MPEP § 804. Particularly in § 804 IIA "Statutory Double Patenting-35 U.S.C. § 101" where it is stated that

> "Same invention" means identical subject matter. Miller v. Eagle Mfg. Co., 151 U.S. 186 (1984); In re Vogal, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).
>
> A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

This is the same test discussed at length in our prior response.

In accordance with judicial authority and the MPEP § 804 as discussed above, the appropriate test for statutory type double patenting is - could a claim in the present application be literally infringed without literally infringing a claim of the

patent. All of the claims of the '950 patent include a motor as an element of apparatus claims or as a necessary part of support structure on which the method claims operate. None of the applicants present claims 15-18 recite a motor or the need for one. Accordingly, the present claims do not recite the same invention as the claims of patent '950. As such, if the present claims are to be rejected, they should be rejected under "obviousness type" double patenting, not statutory double patenting.

The examiner is hereby requested to reconsider and withdraw the statutory double patenting rejection of the claims in the present application.

Submitted herewith is a Request for Extension of Time with authorization to charge the undersigned's deposit account for the cost and a Notice of Appeal.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

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Date: August 13, 2002

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